

EM007146314US

11-28-07

AFD

PTO/SB/21 (07-06)

Approved for use through 09/30/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

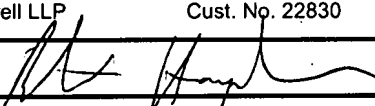
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing) NOV 26 2007 U.S. PATENT AND TRADEMARK OFFICE	Application Number	09/742,699	
	Filing Date	December 20, 2000	
	First Named Inventor	Ajit S. Shah	
	Art Unit	2166	
	Examiner Name	Isaac M. Woo	
Number of Pages in This Submission	15	Attorney Docket Number	PA1273US

**ENCLOSURES (Check all that apply)**

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): 1) Confirmation Postcard; 2) One additional copy of Reply Brief.
<b>Remarks</b> Total page number does not include postcard.		

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name	Carr & Ferrell LLP	Cust. No. 22830
Signature		
Printed name	Robert D. Hayden	
Date	November 26, 2007	Reg. No. 42,645

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name		Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANTS: Ajit S. Shah et al.  
APPLICATION NO.: 09/742,699  
CONF. NO.: 9128  
TITLE: Information Exchange Engine Providing a Critical  
Infrastructure Layer and Methods of Use Thereof  
FILING DATE: December 20, 2000  
EXAMINER: Isaac M. Woo  
ART UNIT: 2166  
ATTY. DKT. NO: PA1273US  
CUSTOMER NO.: 22830

---

MAIL STOP APPEAL BRIEF—PATENTS  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450  
ALEXANDRIA, VA 22313-1450

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Sir:

This reply brief is submitted in response to, and within two months of, the Examiner's Answer to Appeal Brief mailed from the U.S. Patent Office on September 26, 2007.

## REMARKS

The Examiner's points of rebuttal are addressed below in the order in which they appeared in Section 10 of the Examiner's Answer to Appeal Brief, "Response to Arguments."

The Examiner first addressed the Appellants' assertion that the engine of Liu is not configured to determine an identity of a first party to be provided personal information. Appellants note that the pending claims have only been rejected as anticipated, not as obvious, and the Appellants have limited their arguments solely to refuting anticipation. The Examiner incorrectly states, therefore, that Appellants argued that Liu does not teach *or suggest* this limitation. Appellants stress that the absence of an argument against obviousness is in no way an admission that any limitation would have been obvious to one of ordinary skill in the art.

In his rebuttal, the Examiner failed to specifically address the Appellants' arguments with respect to this limitation. The Appellants noted that the Examiner had equated certain components of Liu with certain limitations of the claims, and if these correlations are accepted, that the synchronization software of Liu would have to be configured to determine an identity of the REX handheld device 154 for Liu to read on the limitation of determining an identity of a first party to be provided personal information.

Appellants showed that in Liu, a user is asked to create or select a user name for the REX card. The synchronization software of Liu merely provides a list of known user names or accepts a new user name. It is the user that makes the selection or creates a new name, not the synchronization software. Whether the synchronization software of Liu can be said to be determining an identity of the REX handheld device by merely receiving a user selection hinges on the interpretation of "determine." Appellants therefore provided an analysis of the term "determine" to arrive at the broadest reasonable interpretation that was consistent with the specification. Under the broadest

reasonable interpretation, the act of receiving a user selection of a user name does not read on the limitation of determining an identity of a first party to be provided personal information.

In his response, the Examiner did not indicate that the Appellants had in any way misrepresented the correlations that the Examiner had drawn between the features of Liu and the various claim limitations. The Examiner also did not rebut the Appellants' assertion that for Liu to read on the limitation of determining an identity of a first party the synchronization software of Liu would have to be configured to determine an identity of the REX handheld device 154. Further, the Examiner did not argue that the law and the facts applied by the Appellants to arrive at the broadest reasonable interpretation of "determine" were incorrect or somehow misapplied.

Instead of addressing these arguments and conclusions, the Examiner turned to section 5 of the Appeal Brief, Summary of Claimed Subject Matter, which is merely meant to be a "concise explanation of the subject matter defined in each of the independent claims involved in the appeal." (37 C.F.R. §41.37(C)(1)(v)). The Examiner contends that the cited support in section 5 of the Appeal Brief for the limitation at issue "defines" the claim limitation. This is simply not true. While a claim must be given its broadest reasonable interpretation consistent with the specification, this does not mean that examples given in the specification necessarily define the claim limitations.

Nevertheless, Appellants wish to refute the Examiner's position as put forth in the Examiner's Answer. The Examiner refers to the following portion of the specification, "verify[ing] that the user logging in to the system 102 is a registered user and...retriev[ing] the internal account ID of the user," and concludes that "argued limitations can be understood by 'determining the first party by authorized user logging.'" What the Examiner appears to be suggesting<sup>1</sup> is that the present specification

---

<sup>1</sup> The Board of Patent Appeals and Interferences is invited to review page 10 lines 11-14. These two sentences provide the only articulation of the Examiner's analysis. The Examiner seems to draw a correlation between "identified" and "determined" but the Appellants are unclear how the term "identified"

teaches that when the user logs into the system 102, the system 102 determines the identity of the first party by receiving the log in. Therefore, when the synchronization software of Liu receives a user selection of a user name from the user, the synchronization software determines the identity of the first party. In short, the Examiner appears to be suggesting that merely receiving an input reads on making a determination.

However, this ignores the analysis the Appellants provided in the Appeal Brief. The Appellants showed that the proper interpretation of “determine” is “to establish or ascertain definitely, as after consideration, investigation, or calculation.” This interpretation is arrived at by considering the very language from the present specification that the Examiner cites. The mere act of receiving an input does not ascertain definitely, as after consideration, investigation, or calculation. In the Appeal Brief, the Appellants arrived at the broadest reasonable interpretation of “determine” that is consistent with the specification by showing that the engine of the present invention does more than just receive the user log in when determining the identity of the first party; the engine first verifies that the user is registered and then retrieves the internal account ID. Here, the internal account ID is the identity that is determined in the specification, and the engine determines the internal account ID by the steps of verification and retrieval. Consistent with the definition of “determine” provided above, the engine of the present invention *considers* whether the user is registered, and then the engine *ascertains* the internal account identifier.

In short, the engine in the present invention makes a determination (account ID) based on a received user input (log in); the act of receiving the input is not, in itself, the determination. Thus, where the synchronization software of Liu receives a user selection, the synchronization software is not making any kind of determination. To say that Liu reads on the limitation of “determine an identity” is to say that “receive a user name” reads on “determine an identity,” and that is to say that “receive” reads on “determine.” Such an interpretation of the meaning of “determine” is clearly unreasonably broad in

---

is relevant since the preceding portion of Liu quoted by the Examiner does not use the term. Liu does refer to “the identification” as a noun, whereas “determined” and “identified” are verbs.

view of the present specification. Therefore, Appellants contend that Liu does not anticipate any of the independent claims.

The Examiner next addressed the Appellants' assertion that the engine of Liu is not configured to determine whether a selected field of the personal information of a second party can be provided to the first party. The Examiner again failed to specifically address the Appellants' arguments with respect to this limitation. Starting with the Examiner's correlations between the claim limitations and the features of Liu, including the correlation of the second party in the claims to the computer system 100 of Liu, the Appellants argued that the synchronization software of Liu would have to be configured to determine whether a selected field of the personal information of the computer system 100 can be provided to the REX handheld device 154 in order for Liu to read on the limitation of determining whether a selected field of the personal information of a second party can be provided to the first party. More specifically, for Liu to read on this limitation would require that Liu teach that the personal information is *of* the computer system 100.

Appellants then showed that while Liu may teach user information, the user information is not "of" the computer system 100. Again, Appellants provided an analysis of the broadest reasonable interpretation of "of" that is consistent with the specification to arrive at "with reference to; about." Appellants showed that the user information in Liu was not *about* the computer system 100.

In his response, the Examiner did not rebut the Appellants' assertion that for Liu to read on the limitation of determining whether a selected field of the personal information of a second party can be provided to the first party that the user information of Liu would have to be *about* the computer system 100. The Examiner also did not argue that the law and the facts applied by the Appellants to arrive at the broadest reasonable interpretation of "of" were incorrect or misapplied.

Instead of addressing these arguments and conclusions, the Examiner merely quotes a few seemingly non-pertinent sentences of Liu and in the sole articulation of an analysis states “[t]his abstract teaches that determining a selected field (fig. 3D, fig. 3E) auto-matching for mapping between devices that store personal information (personal information *of* a second party).” Appellants would like to address the Examiner’s rebuttal, however the Appellants are unable to discern the Examiner’s argument from the above. Appellants do not dispute that Liu teaches methods for synchronizing personal information, however the Examiner has equated the second party recited by the pending claims to the computer system 100 of Liu, and the personal information of Liu is not *of* the computer system 100.

Additionally, Appellants wish to note that specific arguments regarding the further patentability of dependent claims 30, 33, and 34 were provided in the Appeal Brief. In his rebuttal, the Examiner did not address the Appellants remarks about these dependent claims. By failing to offer any counter to these arguments, Appellants contend that the Examiner has conceded these points and therefore claims 30, 33, and 34 should be allowed.

In conclusion, the Appellants wish to point out to the Board of Patent Appeals and Interferences that the present invention and the disclosure of Liu are really about two very different subjects. The present invention is directed to “systems and methods for providing dynamic creation, storage and exchange of personal information” (page 1 lines 12-13) through an information exchange system that provides tools for dynamically defining data records, for dynamically allocating instances of those records, and for facilitating electronic exchange of personal information between individuals and the people and businesses with which they interact (page 2 lines 2-8). Liu, on the other hand, is directed to performing synchronizations between devices. Liu teaches a synchronization engine. In Liu, “the user selects a Synchronize button, whereupon the system performs synchronization between two devices” (col. 3 lines 39-41). Further, each of the drawings in Liu that show a screenshot includes the term “TrueSync.”

While our patent law does not require an anticipating reference to be analogous as it does for a reference being used to make an obviousness rejection, it is Appellants' position that the Examiner is essentially trying to fit a square peg into a round hole in rejecting the present claims as anticipated by Liu. Appellants contend that the poor fit of Liu to the present invention really underlies the Examiner's inability to adequately address the Appellants' arguments in the Examiner's Answer. Instead, the Examiner has continued to provide scant analysis to support conclusory statements.

Applicants believe no fee is due with this submission. If a fee is due, however, the Commissioner is hereby authorized to charge any necessary fee to Account Number 06-0600 for a small entity. A copy of this statement is submitted in duplicate for this purpose.

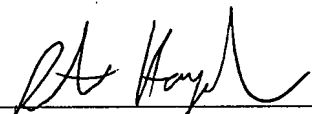
### **CONCLUSION**

Therefore, and in light of the reasons provided in the Appeal Brief, the Appellants request that the Board of Patent Appeals and Interferences overrule the Examiner's rejection of claims 27-49 as being anticipated under 35 U.S.C. § 102(e) by Liu.

Respectfully submitted,  
Ajit S. Shah et al.

November 26, 2007

By:

  
\_\_\_\_\_  
Robert D. Hayden, Reg. No. 42,645  
**Carr & Ferrell LLP**  
2200 Geng Rd.  
Palo Alto, CA 94303  
P: (650) 812-3400  
F: (650) 812-3444